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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,718	01/26/1999	RICK W. LANDSMAN	UNICAST-1CIP	7166

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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/237,718

Applicant(s)

LANDSMAN ET AL.

Examiner

Jeffrey D. Carlson

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 3-10,12-18,20-25,27-33,35,37-44,46-52,54-59,61-67,69,71-78,80-86,88-93,95-102 and 104-108.

Continuation of Disposition of Claims: Claims rejected are 3-10,12-18,20-25,27-33,35,37-44,46-52,54-59,61-67,69,71-78,80-86,88-93,95-102 and 104-108.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 3/25/2002.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-10, 12-18, 20-25, 27-33, 35, 37-44, 46-52, 54-59, 61-67, 69, 71-78, 80-86, 88-93, 95-102 and 104-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judson (US5737619) in view of Capek et al (US6094677). Judson teaches the desire to display locally cached information (such as ads [col. 2 line 2, col. 7 lines 22-25]) to a user's web browser while the user waits for requested page content to be downloaded. Judson states that text or image content could be displayed during such wait periods. In the case of images, the embedded code provides a link to the address of the image file; the content of the image file providing the message/advertisement. This is an example of using tag code to decouple the message/ad/object content from the first web page. Judson describes several processes/tests that determine/control browser function in order to implement the invention. Column 6 lines 13-16 describe that step 74 provides a test to determine whether a link associated with the object/ad is activated. Column 6 lines 18-28 describe a process where the client retrieves and displays the ad object in parallel with the

downloaded of the requested content page. Step 84 includes a test/routine to determine whether the display is complete and allows the display of the requested content page. Column 7 lines 25-33 describe *programming* at the browser level to insert ads randomly, or even selective ads according to the user's history. Column 8 lines 30-43 describe the use of browser-executed Java applets (inherently include scripts and server url) to implement interactive/dynamic ads. Capek et al also describes methods to insert information (inserts can be ads [col. 8 lines 3+]) during delays in retrieving browser requested pages/information. Capek et al describes the use of browser executed applets to accomplish several features such as detecting a client request for remote information [col 7 lines 18-23], determining the future delay duration [col 10 lines 9-12], and selecting relevant ads based on the users profile [col 5 lines 9-12]. It would have been obvious to one of ordinary skill at the time of the invention to have provided code-based applets with that of Judson in a manner as taught by Capek et al so that the tests and routines of Judson can be accomplished. Capek et al teaches the identification of each ad as well as the queuing of ads and playing the ads in a particular order [col 8 line 59 to col 9 line 5]. It would have been obvious to one of ordinary skill at the time of the invention to have downloaded the ads sequentially in the same order as they are to be played. The managers described by Capek et al can be taken to be "agents". It would have been obvious to one of ordinary skill at the time of the invention to have implemented the programming/managers as persistent within the user's browsing session so that other session-specific functions can be carried out as is well known, such as time of session tracking and customizing the ads for the specific

user's session. Column 12 lines 39-42 describe a process of checking the configuration of the user's computer to determine whether a particular type of ad can be played back/displayed. It would have been obvious to one of ordinary skill at the time of the invention to have included a file describing the ad identity (as above) as well as the configuration options needed to successfully play the ad. Regarding claim 12, a new user session would inherently download and invoke the most recently stored applet, however it would have been obvious to one of ordinary skill at the time of the invention to have checked for more recent versions so as to enable programming changes immediately.

Response to Arguments

4. Applicant's arguments filed 3/25/2002 have been fully considered but they are not persuasive. Applicant argues that the combination does not teach applicant's inventive decoupling. The "wherein" clauses in the independent claims are taken to be functional language. While the claims state that the code eliminates the need to store content within the web page, no positive step is provided by such language and even if the combination did so, it would not preclude application of the combination. Further, a reference to an image in a web page is taken to eliminate the need for the web page to store the content of the image. The two are decoupled; if the image file were edited, the changes would be seen interstitially without changing any of the web page coding. Simply changing the ad image files would enable changes to an ad campaign without requiring editing of the web pages themselves. Applicant argues that Judson selection

occurs by the browser reacting to a URL and not tag execution. The independent claims mention no tags or URLs and are not believed to preclude ad selection and display via the browser processing a URL. Further, the combination set forth selects the ads through the scripts/programs of Capek et al. Applicant argues that the particular order of steps differentiates the instant invention from the combination, however, the order of the particular steps is not defined in the claims and the scope of the arguments are narrower than the claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-

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3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc
May 28, 2002